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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,900	06/14/2005	Scott Thomas Milner	2003B133A	6056

23455 7590 04/29/2009

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EXAMINER	
RABAGO, ROBERTO	

ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
04/29/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/538,900	MILNER ET AL.	
	Examiner	Art Unit	
	Roberto Rábago	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 March 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9-18,20-51,53 and 59* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *31* is/are allowed.

6)☒ Claim(s) *1-7,9-18,20-30,32-40,48-51,53 and 59* is/are rejected.

7)☒ Claim(s) *41-47* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on 2/20/2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Pat. 7,414,101 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

2. Claims 1, 9, 10 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vandenberg et al. (US 3,883,449) for the reasons set forth in paragraph 2 of the Office action mailed 11/26/2008.

Applicant's arguments filed 2/20/2009 have been fully considered but they are not persuasive. Regarding claims 1, 9 and 10, applicants have amended the claims to require specific monomers, including vinyl ethers. This amendment fails to overcome the rejection because the reference recommends numerous vinyl ethers which may be added as comonomer, including vinyl glycidyl ether, allyl glycidyl ether, glycidyl methacrylate, glycidyl acrylate, and several others (see col. 3-5). One of ordinary skill in the art would be motivated to include such monomers because they have been suggested by patentee. Regarding claim 29, applicant argues that water would not be present in the reference method in view of reaction with trialkyl aluminum. However, even assuming applicants' proposed 1:1 reaction is correct, and further assuming that

such reaction proceeds to 100% completion, the use of at least a measurable amount of excess water in the reference process would be obvious because patentee recommends that water be used as part of the catalyst in an amount of up to 1.5 mole per mole of Al (see col. 7, lines 18-22).

Double Patenting

3. Claims 1, 9, 10, 28, 2-7, 11-18, 20-30, 32, 33, 35-40, 48-50, 53 and 59 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-58 of Application 11/728,306, for the reasons set forth in paragraph 4 of the Office action mailed 11/26/2008.

4. Claims 1, 9, 10, 22-25, 32 and 59 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 120-161 of Application 11/628,608 for the reasons set forth in (the second) paragraph 4 of the Office action mailed 11/26/2008.

5. Claims 28, 2-7, 26, 30, 32, 34-40, 49, 51 and 59 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of Patent 7,402,636, for the reasons set forth in paragraph 5 of the Office action mailed 11/26/2008.

6. Applicants' arguments filed 2/20/2009 in traversal of the obviousness-type double patenting rejections have been fully considered but they are not persuasive. Applicants argue that insufficient basis for obviousness of the broader claims over the narrower copending claims has been provided. In each of the three rejections, the instant claims are broader than the copending claims (and therefore anticipated) except that the copending claims do not recite the pressure and temperature requirements of the instant claims. However, basis has been provided as to why such embodiments would have been obvious (see text of each rejection from the prior office action), and applicants have provided no traversal of the specific grounds of obviousness previously set forth. The balance of applicants' argument essentially amounts to asserting that a two-way test for obviousness is required to support an obviousness-type double patenting rejection in this application, and that insufficient basis exists to conclude that the claims of the later-filed applications or patent are obvious over the instant claims. A two-way test is required only when both of the following criteria are met: (a) applicants could not have avoided separate filings, and (b) the record clearly shows that PTO administrative delay is responsible for causing the applications to issue out of order (see MPEP 804 II. B. 1. (b)). In this case, requirement (a) is met because the cited patent and applications recite additional structure not disclosed in this application. Regarding (b), applicants state that they "have not intentionally delayed any prosecution in the present application." However, review of the record shows otherwise. In fact, applicants have twice elected the maximum permissible delay in prosecuting the subject matter of this application. This application claims priority to a provisional application

filed 12/20/2002, followed by a PCT application filed just prior the 12-month expiration of the provisional, followed by a national stage application 18 months later. At each of these stages, applicants elected the maximum delay in filing the instant US application; in combination with several requests for extension of time in responding to Office actions, the total delay by applicants in filing/prosecuting the US application amounted to almost three years. These delays sought by applicants were clearly their choice; had this application been filed at the earliest opportunity available, the instant claims could have been allowed or patented prior to the filing of any of the documents which now form the basis of obviousness-type double patenting. In view of the lengthy prosecution delays sought by applicants, only a one-way test is required, and therefore the instant claims are properly rejected as obvious over the claims of the cited patent and applications.

7. Claim 31 is allowed. Claims 41-47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roberto Rábago/
Primary Examiner
Art Unit 1796

RR
April 27, 2009